

REMARKS

The Office Action dated June 13, 2007 has been carefully reviewed. Claims 41-50 stand rejected in the 6/4/2007 Office Action under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,451,404 issued to Furman (hereinafter “Furman”) in view of JP 06-157327 (hereinafter “JP ‘327”) and the article entitled “Differences in human evoked potentials related to olfactory or trigeminal chemosensory activation” by Hummel et al (hereinafter “Hummel”). Reconsideration of claims 41-50 in light of the remarks presented herein is respectfully requested.

Discussion Re: Claims 41-43 and 46

On page 4 of the 6/13/2007 Office Action, the Examiner asserted the following with regard to claims 41-43 and 46:

Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention to deliver **tissue impregnated with a stimulating organic substance including menthol or camphor as disclosed by Furman, and use the impregnated tissue to decrease drowsiness as disclosed by JP ‘327 because JP ‘327 teaches that menthol and camphor used externally for preventing drowsiness and meanwhile giving excellent feeling in use and having prolonged activity...**

(emphasis added). Applicants respectfully traverse these rejections. Applicants believe the Examiner has failed to establish a *prima facie* case of obviousness because JP ‘327 actually teaches away from the proposed combination. *See KSR v. Teleflex, Inc.*, 127 S.Ct. 1727, 1740 (“[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.”).

When conducting an analysis of obviousness, the Examiner is required to consider the prior art “in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention.” *W.L. Gore & Assoc. v. Garlock*, 721 F.2d 1540, 1550-51 (Fed. Cir. 1983) (emphasis added). The prior art effectively teaches away when an examiner’s proposed modification of prior art renders the prior art invention “inoperable for its intended purpose.” *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984). In the instant case, JP ‘327 “aims at offering the *lasting* high external preparations for sleepiness prevention and *patches* excellent in a feeling of use.” JP ‘327, ¶ 0006 (emphasis added).

To achieve the lasting and effective drowsiness prevention, JP '327 teaches attaching the adhesive patches to a user's body for at least "0.5, 1 and 1.5, and 2 or 2.5 hours." JP '327, ¶ 0051; *see also id.* at ¶ 0003-5 (discussing the drawbacks of oral ingestion, inhalation, and other patches in providing lasting drowsiness prevention). The proposed combination, on the other hand, would have the user in contact with the impregnated tissue for only a very limited period of time. Indeed, by its very nature, a tissue or towelette is wiped over the skin quickly and then is disposed of, which makes extended contact with the skin of the user not possible. Because JP '327 teaches that drowsiness prevention agents not in contact with the body for extended periods have limited effectiveness, the reference teaches away from the use of an impregnated tissue in drowsiness prevention. As a result, the rejection of claims 41-43 and 46 on obviousness grounds is unsustainable and should be withdrawn.

Additional Discussion Re: Claims 42-46

Even if, for argument's sake, the references could be combined in the manner proposed, the combination does not arrive at the invention of claims 42-46. In the instant case, each of claims 42-46 contain the limitation "the ammonia containing substance comprising .25% to 5% ammonia by weight." Respectfully, this limitation is not taught or suggested by Furman, JP '327, or Hummel.

The Board of Patent Appeals and Interferences has said that "[t]o establish the obviousness of the claimed subject matter, all the claim limitations must be taught or suggested by the prior art." *Ex Parte Foley*, 2007 WL 2272397, *2 (Bd. Pat. App. & Interf. 2007); *see* MPEP 2143.03. The Examiner proposed on page 4 of the 6/13/2007 Office Action that "Hummel et al. teaches that ammonia provides nerve stimulation at large amplitude (see the provided abstract)." *See also* 6/13/2007 Office Action, at 3 (stating that Furman does not teach the use of ammonia in the composition and indicating JP '327 likewise fails to teach the limitation). Yet the Hummel abstract makes no mention of the amount of ammonia used in the experiments. Thus, the Examiner failed to propose a combination that teaches or suggests all limitations of claims 42-46 because at least one

limitation is absent from the proposed combination. As a result, a *prima facie* case of obviousness has not been established, and the rejection of claims 42-46 should be withdrawn.

Discussion Re: Claim 47 and 48

Claims 47 and 48 include claim 41 as a base claim. As a result, the rejection of claims 47 and 48 should be withdrawn for the reasons hereinbefore discussed with regard to claim 41. *See In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988) ("Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious."). In light of the overwhelming reasons for withdrawal of the rejection of claim 41, any arguments specific to claims 47 and 48 are held in abeyance without prejudice or admission to any assertion made by the Examiner in order to expedite prosecution.

Discussion Re: Claim 49 and 50

Claims 49 and 50 include claim 41 as a base claim. As a result, the rejection of claims 49 and 50 should be withdrawn for the reasons hereinbefore discussed with regard to claim 42. *See In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988) ("Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious."). In light of the overwhelming reasons for withdrawal of the rejection of claim 42, any arguments specific to claims 49 and 50 are held in abeyance without prejudice or admission to any assertion made by the Examiner in order to expedite prosecution.

CONCLUSION

In view of the foregoing remarks, it is submitted that this application is in a condition for allowance. Action to that end is hereby solicited.

In the event that there are any questions related to this response in particular, or to the application in general, the undersigned would appreciate the opportunity to address those questions directly in a telephone interview to expedite the prosecution of this application for all concerned.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and shortages in other fees be charged, or any overpayment in fees be credited, to the Account of Barnes & Thornburg, Deposit Account No. 10-0435 with reference to file 31797-70009.

Respectfully submitted,

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